UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/777,717	02/12/2004	Christopher James Dawson	AUS920030842US1	5923

45371	7590	06/21/2006

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EXAMINER
ALLEN, WILLIAM J

ART UNIT	PAPER NUMBER
3625	

DATE MAILED: 06/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	10/777,717	DAWSON ET AL.
	Examiner	Art Unit	
	William J. Allen	3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE **3** MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *12 February 2004*.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-41* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-41* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on *12 February 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *2/12/2004*.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 101

1.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2.   **Claims 13-24 and 25-36 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

Regarding claims 13-24 and 25-36: claims to computer-related inventions that are clearly nonstatutory fall into the same general categories as nonstatutory claims in other arts, namely natural phenomena such as magnetism, and abstract ideas or laws of nature which constitute "descriptive material." Abstract ideas, Warmerdam, 33 F.3d at 1360, 31 USPQ2d at 1759, or the mere manipulation of abstract ideas, Schrader, 22 F.3d at 292-93, 30 USPQ2d at 1457-58, are not patentable. Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to music, literary works and a compilation or mere arrangement of data. <u>Both types of "descriptive material" are nonstatutory when claimed as descriptive material per se. Warmerdam, 33 F.3d at</u>

1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Independent **claim 13** fails to recite a computer executable program that is embodied on a computer-readable medium. Independent **claim 25** fails to show imparted functionality and is merely drawn to a data structure (i.e. a *token* containing information). As defined by Microsoft Press Computer Dictionary, Third edition, a token is "a unique structured data element that circulates continuously among nodes of a token ring". Alternatively, a token may be considered "any non-reducible textual element in data that is being parsed". In either case, claim 25 is directed to a disembodied data structure/data per se, which is considered non-statutory subject matter.

Claim Rejections - 35 USC § 102

3.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4.   **Claims 1, 13, and 25 are rejected under 35 U.S.C. 102(e) as being

anticipated by Tackman et al. (US 7,051,364, herein referred to as Tackman).**

Regarding claim 1, Tackman teaches *creating a contract between a buyer and

a seller in an online transaction by means of a shopping token that contains a plurality

of agreements* (see at least: Fig. 3-10, col. 6 line 43-col. 11 line 53).

Regarding claims 13 and 25, the limitations set forth in claims 13 and 25 closely

parallel the limitations set forth in claim 1. Claims 13 and 25 are thereby rejected under

the same rationale.

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6.   Claims 2-8, 14-20, 26-32, and 37 are rejected under 35 U.S.C. 103(a) as

being unpatentable over Tackman in view of Yehia et al. (US 2002/0091614, herein

referred to as Yehia).

Regarding claims 2-5, Tackman teaches:

(2) *creating a file and saving the file in response to the addition of a buyer digital*

signature and a seller digital signature (see at least: col. 6 line 43-col. 11 line 53, Fig. 3,

6, and 10); The Examiner notes that a digitally signed Electronic Agreement is stored on

the server;

(3) *adding a seller's personal information, a buyer's personal information,*

information regarding the good, and a plurality of terms to the file (see at least: Fig. 3, 6-

10);

(4) *presenting the terms to the buyer* (see at least: Fig. 2,3, 6-10);

determining whether the buyer and seller agree with the terms (see at least: Fig.

3,10); Note steps 340 and 350 of Figure 3;

responsive to the determination that the buyer and seller agree with the terms,

means for adding a buyer digital signature and a seller digital signature to the file to

create a shopping token (see at least: Fig. 3, 10);

(5) *responsive to the determination that the buyer and seller do not agree with*

the terms, means for accepting a modification to the terms (see at least: abstract, Fig. 3,

6-9, col. 2 lines 30-55, col. 9 lines 28-55)

Tackman teaches all of the above as noted and further teaches where the

invention may be practiced using in a number of program modules utilizing various

programming languages (see at least: col. 12 lines 20-26, Fig. 6). Tackman, however,

does not expressly teach that the files are written in *XML*. Yehia teaches the use of XML

in document creation and data transfer (see at least: 0029-0034, 0072). Yehia also

teaches indicating multiple terms, such as delivery date, before a contract is

implemented (see at least: abstract, 0022). It would have been obvious to one of

ordinary skill in the art at the time of invention to have modified the invention of

Tackman to have included where the files are written in *XML* taught by Yehia in order to

provide a system architecture to: (1) automatically reconcile and coordinate related

contracts in a value chain to ensure consistency among the contracts between the

trading partners in the value chain, (2) automatically generate warnings and take

actions for any inconsistencies, (3) streamline the contract generation process, and (4)

enable service providers to automatically and programmatically negotiate service

contracts (see at least: Yehia, 0062).

Regarding claims 14-17 and 26-29, the limitations set forth in claims 14-17 and

26-29 closely parallel the limitations set forth in claims 2-5. Claims 14-17 and 26-29 are

thereby rejected under the same rationale.

Regarding claim 6, Tackman teaches all of the above as noted and further

teaches a "contract date" of the electronic agreement (see at least: col. 12 lines 20-26,

Fig. 6). Tackman, however, does not expressly teach *wherein the shopping token is*

created after the buyer is aware of the delivery date. Yehia teaches the use of XML in

document creation and data transfer (see at least: 0029-0034, 0072). Yehia also

teaches indicating multiple terms, such as delivery date, before a contract is

implemented (see at least: abstract, 0022). It would have been obvious to one of

ordinary skill in the art at the time of invention to have modified the invention of

Tackman to have included *wherein the shopping token is created after the buyer is*

aware of the delivery date as taught by Yehia in order to provide a system architecture

to: (1) automatically reconcile and coordinate related contracts in a value chain to

ensure consistency among the contracts between the trading partners in the value

chain, (2) automatically generate warnings and take actions for any inconsistencies, (3)

streamline the contract generation process, and (4) enable service providers to

automatically and programmatically negotiate service contracts (see at least: Yehia,

0062).

Regarding claims 18 and 30, the limitations set forth in claims 18 and 30 closely parallel the limitations set forth in claim 6. Claims 18 and 30 are thereby rejected under the same rationale.

Regarding claims 7 and 8, Tackman further teaches:

(7) *wherein the shopping token may be configured so that the shopping token is not modifiable by the buyer or seller* (see at least: abstract, col. 2 lines 47-55, col. 8 lines 9-45, col. 10 lines 63-66);

(8) *wherein the shopping token is stored on a third party computer and is accessible by the buyer and the seller* (see at least: Fig. 2, col. 9 lines 28-31, col. 10 line 60-col. 11 line 2).

Regarding claims 19-20 and 31-32, the limitations set forth in claims 19-20 and 31-32 closely parallel the limitations set forth in claims 7-8. Claims 19-20 and 31-32 are thereby rejected under the same rationale.

Regarding claim 37, Tackman teaches:

a means for creating a file (see at least: col. 6 line 43-col. 9 line 55, Fig. 3 and 6);

a means for adding a seller's personal information, a buyer's personal

information, information regarding the good, and a plurality of terms to the file (see at

least: Fig. 3, 6-10);

means for presenting the terms to the buyer (see at least: Fig. 2,3, 6-10);

means for determining whether the buyer and seller agree with the terms (see at

least: Fig. 3,10); Note steps 340 and 350 of Figure 3;

responsive to the determination that the buyer and seller agree with the terms,

means for adding a buyer digital signature and a seller digital signature to the file to

create a shopping token (see at least: Fig. 3, 10);

responsive to the determination that the buyer and seller do not agree with the

terms, means for accepting a modification to the terms (see at least: abstract, Fig. 3, 6-

9, col. 2 lines 30-55, col. 9 lines 28-55);

wherein the shopping token may be configured so that the shopping token is not

modifiable by the buyer or seller (see at least: abstract, col. 2 lines 47-55, col. 8 lines 9-

45, col. 10 lines 63-66);

wherein the shopping token is stored on a third party computer and is accessible

by the buyer and the seller (see at least: Fig. 2, col. 9 lines 28-31, col. 10 line 60-col. 11

line 2).

Tackman teaches all of the above as noted and further teaches where the

invention may be practiced using in a number of program modules utilizing various

programming languages, as well as a "contract date" of the electronic agreement (see

at least: col. 12 lines 20-26, Fig. 6). Tackman, however, does not expressly teach that

the files are written in *XML* and *wherein the shopping token is created after the buyer is*

aware of the delivery date. Yehia teaches the use of XML in document creation and

data transfer (see at least: 0029-0034, 0072). Yehia also teaches indicating multiple

terms, such as delivery date, before a contract is implemented (see at least: abstract,

0022). It would have been obvious to one of ordinary skill in the art at the time of

invention to have modified the invention of Tackman to have included where the files

are written in *XML* and *wherein the shopping token is created after the buyer is aware of*

the delivery date as taught by Yehia in order to provide a system architecture to: (1)

automatically reconcile and coordinate related contracts in a value chain to ensure

consistency among the contracts between the trading partners in the value chain, (2)

automatically generate warnings and take actions for any inconsistencies, (3) streamline

the contract generation process, and (4) enable service providers to automatically and

programmatically negotiate service contracts (see at least: Yehia, 0062).

7.   **Claims 9, 21, 33, and 38 are rejected under 35 U.S.C. 103(a) as being**

unpatentable over Tackman in view of Yehia as applied to claim 37 above, and

further in view of Martin et al. (US 2002/0116282, herein referred to as Martin).

Regarding claim 9, Tackman in view of Yehia teaches all of the above as noted

and further teaches creation of a shopping token containing a plurality of agreed upon

terms (see at least: Tackman col. 6-col. 9, Fig. 3). Tackman also illustrates the invention

by creating a contract to purchase a vehicle (see at least: Fig. 6-10). The Examiner

notes that purchasing a vehicle usually entails some type of service/warranty agreement

as part of the vehicle purchase. Though it is strongly suggested, Tackman in view of

Yehia does not expressly teach *wherein the shopping token contains warranty*

information for the good. Martin teaches adding/providing warranty terms as part of a

contract (see at least: 0114). It would have been obvious to one of ordinary skill in the

art at the time of invention to have modified the invention of Tackman in view of Yehia to

have included *wherein the shopping token contains warranty information* as taught by

Martin in order to provide a combination of standardized terms from a supplier, allowing

a customer to more easily consider terms (see at least: Martin, 0114).

Regarding claims 21, 33, and 38, the limitations set forth in claims 21, 33, and

38 closely parallel the limitations set forth in claim 9. Claims 21, 33, and 38 are thereby

rejected under the same rationale.

8.   Claims 10-12, 22-24, 34-36, and 39-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tackman in view of Yehia as applied to claim 37 above, and further in view of Moss et al. (US 2005/0160014, herein referred to as Moss).

         Regarding claims 10-12, Tackman in view of Yehia teaches all of the above as noted and further teaches creation of a shopping token containing a plurality of agreed upon terms for purchasing (see at least: Tackman col. 6-col. 9, Fig. 3). Tackman in view of Yehia, however, does not expressly teach *wherein the shopping token is used for price protection and price promotion for the good, and to analyze a seller's history by a buyer.* Moss teaches *wherein the shopping token is used for price protection and price promotion for the good* (see at least: 0007, 0032, 0047, Fig. 30-31). Note the price matching includes the retailer's own advertised prices (Fig. 31). Additionally, Moss teaches a *buyer analyzing the history of a seller* by providing a buyer with the ability to view transactions within the last 3 months or since joining the service ("historical price match transactions") to determined the outcome and savings received from each transaction (see at least: 0082, Fig. 4). The Examiner notes that each transaction shows an associated seller and the amount saved by using that seller, thereby providing a *seller history* for the buyer. It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Tackman in view of Yehia to have included *wherein the shopping token is used for price protection and price promotion for the good* as taught by Moss in order to provide a service that helps users find and compare the best prices and promotions available (see at least: Moss, 0006).

Regarding claims 22-24, 34-36, and 39-41, the limitations set forth in claims 22-

24, 34-36, and 39-41 closely parallel the limitations set forth in claims 10-12. Claims 22-

24, 34-36, and 39-41 are thereby rejected under the same rationale.

Conclusion

9.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- US 6141653 to Conklin et al. discloses a system for interactive, multivariate negotiations over a network

- US 5677955 to Doggett et al. discloses an electronic funds transfer instruments

- US 5191613 to Graziano et al. discloses a knowledge based system for document authentication

- US 20020062249 to Iannacci discloses a system and method for an automated benefit recognition, acquisition, value exchange, and transaction settlement system using multivariable linear and nonlinear modeling

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William J. Allen whose telephone number is (571) 272-1443. The examiner can normally be reached on 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rob Pond can be reached on (571) 272-6760. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

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For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

William J. Allen
Patent Examiner
June 12, 2006